



UNITED STATES PATENT AND TRADEMARK OFFICE

MW

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/547,540	04/12/2000	William Allocca	249768019US2	5837
25096	7590	03/02/2004	EXAMINER	
PERKINS COIE LLP PATENT-SEA P.O. BOX 1247 SEATTLE, WA 98111-1247			GARG, YOGESH C	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 03/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/547,540

Applicant(s)

ALLOCA ET AL.

Examiner

Yogesh C Garg

Art Unit

3625

ML

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 13-27, 29-33, 35-38, 40, 41, 50-65, 67, 68 and 129 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 13-27, 29-33, 35-38, 40, 41, 50-65, 67, 68 and 129 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Appeal Brief

1. Applicant's appeal brief, paper # 16, is acknowledged and entered. The applicant's arguments filed on 12/08/2003 on pages 27-30 of the appeal brief are persuasive concerning rejection of claims 1-8 and 52 under 35 U.S.C. 112, first paragraph submitted in the last Final action and, therefore, the finality of that action is withdrawn. No amendments have been made. Currently claims 1-10, 13-27, 29-33, 35-38, 40-41, 50-65, 67-68 and 129 are pending.

Response to Arguments

2. Applicant's arguments, see pages 27-30, filed on 12/08/2003, with respect to claims 1-8 and 52 under 35 U.S.C. 112, first paragraph submitted have been fully considered and are persuasive. The rejection of claims 1-8 and 52 under 35 U.S.C. 112, first paragraph, has been withdrawn.

3. Applicant's arguments filed, see pages 12-27 concerning claims 1-10, 13-27, 29-33, 35-38, 40-41, 50-65, 67-68 and 129 have been fully considered but they are not persuasive for following reasons.

(i) The applicant argues (see Issue A, page 7 of the appeal brief) that the examiner has failed to establish a prima facie case of obviousness because none of the cited references teach alone or in combination using multiple predefined procurement options while ordering using a computerized system and that each procurement option have associated information of multiple types including at least payment and delivery information. The examiner

Art Unit: 3625

respectfully disagrees. Reference Hartman explicitly teaches using a computerized system for ordering items such FIG.1C, reference number 108 discloses a " Ship to" , "Shipment Method", and a "Payment Method " information.). The examiner acknowledged that the Hartman reference does not disclose using multiple predefined procurement options. However, this missing limitation is clearly suggested in the Yamada reference, which is also directed to the same field of endeavor of electronic commerce , see at least following Figures and segments from Yamada reference::

FIG. 2 (see "Step 7-Select Place where to deliver"), FIG. 4 (see " Station Setting "), FIG.5 (see the various options provided for choosing a delivery destination), FIG.6 (discloses several predefined choices for delivery destination), FIG.9 ((discloses several predefined choices for delivery destination).

col.1, lines 12-44 *"The present invention provides an online shopping system comprising: a server.....and a plurality of pieces of customers' terminal equipment electrically connected to the server,, order information transmitted from the terminal equipment to the server when the order is made including delivery information indicating at least either one of each customer's place of residence, customer's designated place, a place where the commodity is kept temporarily or each customer's designated person's place of residence as a place where the commodity should be delivered. "* Also see col.3, lines 6-18, and col.4, lines 27-31.

Disclosing several predefined choices for delivery destination clearly corresponds to multiple pre-defined procurement options and satisfies the limitation recited in the independent claims 1, 10, and 29.

The Examiner further submitted the motivation for combining Hartman and Yamada on page 10 of the previous action for the obvious reason that the incorporation of Yamada's feature

Art Unit: 3625

of using multiple predefined choices for delivery information will present convenience to the buyer of having multiple predefined procurement options to be able to select for getting the ordered item delivered to either his residence, office place, a convenience store from where he can collect the item as per his convenience, as a gift to a friend's address.

(ii) The applicant argues (see Issue B, pages 7-8) of the appeal brief) that the examiner has failed to establish a prima facie case of obviousness because none of the cited references teaches or suggests each of the following recited additional claim elements. The examiner respectfully disagrees. The reference Hartman/Yamada teaches the following additional elements:

-- that the procurement option selected to order the item further includes "shipping instructions" along with the payment and delivery information such that the ordering request for an item based on the selected procurement option is additionally to deliver the item as specified by the shipping instructions? (See at least FIG. 1C, reference number 108 discloses a " Ship to" , "Shipment Method: Standard Domestic Shipping", and a "Payment Method " information. In Hartman, , "Shipment Method: Standard Domestic Shipping" corresponds to the claimed shipping instructions along with the payment and delivery information to " John Doe at Home".).

- that each of the procurement options is predefined for the user so as to "include a unique combination of a delivery address, shipping instructions distinct from the delivery address, and a payment source", or each has a "distinct combination" of multiple types of information that is "sufficient to complete an order" for the identified item? (See the analysis above on Yamada reference which discloses predefined multiple choices for different delivery addresses/destinations and therefore when Hartman is combined with Yamada the combined art of Hartman/Yamada discloses unique combination of a delivery address- buyer's residence, office place, a convenience store from where he can collect the item as per his convenience, as

Art Unit: 3625

a gift to a friend's address, as disclosed in Yamada, and shipping instructions and a payment source, as disclosed in Hartman. The motivation to combine Yamada with Hartman is suggested in Yamada as discussed and analyzed above.

- that in addition to displaying indications of the multiple predefined procurement options to the user for use in ordering an item, also displaying an additional user-selectable indication to allow the user to interactively create a new procurement option that will be used to order the item? (see Yamada at least Figs 4-6, and col.4, lines 31-40, " *FIG. 4. Station change can be done at this stage. When the customer 3 sets or changes the station 1 and/or 2, he or she selects one of the states listed on lower part of the screen and clicks SET. FIG. 4 indicates that the customer 3 selects New York. The display on the screen changes to a display as shown in FIG. 5 where the customer 3 selects Manhattan. Then, the customer 3 clicks STATION LIST. Several stations (24-hour opened convenience stores) appear on the screen as shown in FIG. 6 where the customer 3 selects one station and clicks STATION 1 or STATION 2.* Note: Yamada, here explicitly discloses that the user interactively changes the delivery destination, thereby, creating a new option as per his requirement while placing the order.).

- that indications for the multiple predefined procurement options are displayed to the user so that the user can order an item using the item ordering information from one of the procurement options by merely selecting the displayed indication for that procurement option? (Hartman discloses use of 1-click order mechanism, see FIG.1C but it does not disclose using this mechanism for multiple predefined procurement options. However, as analyzed and discussed above Yamada teaches using and displaying multiple predefined procurement options while ordering an item on Internet. It would be obvious to one of an ordinary skilled in the art at the time of the invention to combine Yamada's feature of multiple predefined

Art Unit: 3625

procurement options with Hartman allowing the users to use a single-click option to select the choice from a number of available choices as taught in Yamada. Doing so will present convenience to the buyer of having multiple predefined procurement options to be able to select for getting the ordered item delivered to either his residence, office place, a convenience store from where he can collect the item as per his convenience, as a gift to a friend's address (as disclosed in Yamada) by merely selecting the option, using single-click ordering system to reduce the number of buyer interactions needed to place the order and also to reduce the amount of sensitive information that is transmitted between client system and server (see Hartman, col.3, lines 33-38).

This is a Final action, necessitated due to amendments presented in the amendment B, paper # 12.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3.1. Claims 1-7, 9-10, 13, 15-27, 29-33, 35, 37-38, 40-41, 50-65, 67-68, and 129 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartman et al. (US Patent 5,960,411), hereinafter referred to as Hartman, in view of Yamada (US Patent 6,336,100 B1).

Art Unit: 3625

Note: rejection of claims 1-7 and 52 is being done in the light of 35 U.S.C. 112, first paragraph rejection made above.

With regards to 1, 9, 10, 29, 31, 32, 33, 40, 41, 50, 56, 59, 64, 67, and 68, Hartman discloses a method, a system, a computer-readable medium, and a display device for assisting a user at a client system to place an order for an item to be received by a server system. The client system displays the information identifying the item, an element representing order fulfillment instructions for the identified item, receiving indication of the recipient with predefined order fulfillment information including a unique combination of a delivery address, shipping instructions distinct from the delivery address, and a payment source/information, such that the payment information for procurement option will be used to pay for the identified item and such that delivery information for that procurement option will be used for the delivery of the identified item, and after selection by the user of a displayed indication, without further intervention, sending to server computer a request to order the identified item such that the identified item is to be sent to the delivery address for the selected recipient using the shipping instructions and to be paid for by the payment source for the selected recipient, so that a single action orders and pays for the item (see at least FIGS 1A-1C, 2-7, 8A-8C, col.2, line 50-col.9, line 53. Note: In FIG.1C, reference number 108 discloses a " Ship to" , "Shipment Method: Standard Domestic Shipping", and a "Payment Method " information. In Hartman, , "Shipment Method: Standard Domestic Shipping" corresponds to the claimed shipping instructions along with the payment and delivery information to " John Doe at Home". The combination of ship to instructions, shipment method instructions and payment instructions correspond to an unique combination of delivery, shipping instructions different from delivery address and payment source/information).

Hartman also teaches to create new procurement option for ordering the identified item (see at least Fig.1B, "...Review or change your 1-click orders ", col.4, line 59-col.5, line 8).

Art Unit: 3625

Hartman further teaches that a client identifier corresponds to multiple customers and these multiple customers can be identified by selecting a partially displayed purchaser-specific order information (see at least col.9, lines 54-63).

Hartman does not expressly teach displaying multiple groups/procurement options associated with a single user of the client system having information related to ordering the identified item. Yamada, in the same field of online shopping, teaches displaying multiple groups/procurement options associated with a single user of the client system having information related to ordering the identified item and allowing the user to select one of the multiple groups/procurement options (see at least FIGS. 2, 4, 5,6,9, col.1, lines 12-44, col.2, lines 57-65, col.3, lines 6-18, col.4, lines 15-30. Disclosing several predefined choices for delivery destination clearly corresponds to multiple pre-defined procurement options and satisfies the limitation recited in the independent claims 1, 10, and 29). In view of Yamada, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to modify Hartman to display multiple groups/procurement options having information related to ordering the identified item as expressly taught in Yamada. Thus, when Yamada is combined with Hartman, for each different delivery address, would result in unique combinations of delivery address, shipping instructions different from delivery address, and payment source/information. Doing so would allow the user the novelty and the convenience to order items online for different destinations for him and/or gifts for individuals other than him (see at least col.1, lines 11-44, and col.3, lines 6-19). Note: different destinations mean customer's/user's home addresses or customer's designated addresses such as company addresses and other addresses for individuals other than him as explicitly disclosed in Yamada (see at least col.1, lines 11-44, and col.3, lines 6-19).

Art Unit: 3625

Hartman/Yamada further teaches all the limitations cited in claims 2-7, 13, 15-27, 30, 35, 37, 38, 51-55, 57-58, 60-63, 65, and 129, (see Hartman, col.2, line 51-col.10, line 14, and Yamada, col.1, line 19-col.5, line 20).

3.2 Claims 8, is rejected under 35 U.S.C. 103(a) as being obvious over Hartman/Yamada in view of Official Notice.

With regards to claim 8, Hartman/Yamada teaches a method for a user at a client system to place an order for an item, the user having a plurality of groups of predefined order fulfillment information as disclosed in claim 1 and analyzed above. Hartman/Yamada does not disclose displaying an indication selecting a default groups out of the identified multiple groups. Official Notice is taken of both the well-known concept and benefits of providing a default program while working on the computers when several choices are available to the user to select one. If a user does not specify an alternative the program makes a choice automatically. In view of this well-known concept and its benefits it would have been obvious to a person of an ordinary skill in the art at the time of the invention to include default program in Hartman/Yamada because if a user wants the purchased item to be delivered at his home then he can save time by not being bothered to select delivery information (see at least Yamada, Fig.9, col.3, lines 6-19) as the default program will automatically indicate the server in Hartman/Yamada to select home address if the user has not made any selection of the available multiple groups.

3.3. Claims 14, and 36, are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartman/Yamada in view of Holland et al. (US Patent 6,493,742), hereinafter referred to as Holland.

Art Unit: 3625

With regards to claims 14, and 36, Hartman/Yamada teaches a method for a user at a client system to place an order for an item by indicating a single action, wherein the user have multiple procurement options of predefined order fulfillment information as disclosed in method claims 10, and 33, and analyzed above. Hartman/Yamada discloses indicating a selection of an option to deliver the item as a gift (see at least Yamada col3., lines 6-12). Hartman/Yamada does not disclose that the order request includes wrapping instructions for the item to be delivered. As per knowledge generally available wrapping gifts before delivering to the recipients is notoriously well known practice. In the same field of on online ordering gifts, Holland teaches including wrapping instructions while ordering a gift (see at least col.1, lines 26-46). In view of Holland and knowledge generally available it would have been obvious to a person of an ordinary skill in the art at the time of the invention to include the wrapping

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Art Unit: 3625


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 703-306-0252. The examiner can normally be reached on M-F(8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent A Millin can be reached on 703-308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Yogesh C Garg
Examiner
Art Unit 3625

YCG
March 1, 2004


Jeffrey A. Smith
Primary Examiner